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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/784,677	02/23/2004	Bernd Gugel	10854ABCD	1938
23389 7590 07/09/2007 SCULLY SCOTT MURPHY & PRESSER, PC 400 GARDEN CITY PLAZA SUITE 300 GARDEN CITY, NY 11530			EXAMINER WILSON, JOHN J	
			ART UNIT 3732	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/784,677

Applicant(s)

GUGEL ET AL.

Examiner

John J. Wilson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 March 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 33,34,36-45,47 and 48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 33,34,36-45,47 and 48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 36 and 37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 36, line 1, "said handle" and in claim 37, line 2, "the coupling terminal" lack antecedent basis within the claims.

Claim Rejections - 35 USC § 102

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 44 and 45 are rejected under 35 U.S.C. 102(b) as being anticipated by Black (2696049). Black shows a dental abrasive instrument including a handpiece having a longitudinal bore 67, 68, first portion 59, second portion 63, a hollow tip 14 detachably fastened to the head at 73 and with a fluid connection as shown, and where the second portion 59 is detachably fastenable to supply means at 57, 58. The connection 62, 64, 65 between the first and second handpiece portions is inherently capable of relative rotational movement.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 36, 40 and 42-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Conger, Sr. (4648840) in view of Sadohara (4608017). Conger shows a hand piece 1, handle 4, hollow needle 13, for discharge of abrasive "A", Fig. 2, and fluid, column 4, lines 2-14, coupling 2 connected to a supply line 3 and means 12 for detachably connecting the needle 13, column 4, lines 23-48. Conger does not show rotating portions. Sadohara shows using rotating portions 18, 20, that maintain rotation along a longitudinal axis. It would be obvious to one of ordinary skill in the art to modify Conger to include using rotating sleeves as shown by Sadohara in order to allow for easier positioning of the tool within the mouth of the patient. As to claim 40, Conger teaches the coupling is for gas, air and therapeutic agent, that is, water, column 3, line 60 through column 4, line 2.

Claims 34, 38, 39 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Conger, Sr. (4648840) in view of Sadohara (4608017) as applied to claim 44 above, and further in view of Maurer et al (2643456) and Fischer (5289919). The above combination does not show a plurality of needles having different shapes, sizes and opening sizes. Maurer teaches using a plurality of needles having different shapes and opening sizes, Figs. 12-21. It would be obvious to one of ordinary skill in the art to modify the above combination to include using a plurality of nozzles as shown by Maurer in order to better apply the abrasive in the desired manner. That different

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sizes can be used is an obvious matter of choice in the size of known elements to one of ordinary skill in the art in order to best reach desired areas in the mouth of the patient. The above combination does not show using colored markings. Fischer teaches different size tips having color markings, column 4, lines 12-25. It would be obvious to one of ordinary skill in the art to modify the above combination to include color markings as shown by Fischer in order to distinguish the different tips used. To associate the color markings with different therapeutic agents is merely a matter of mental interpretation and/or intended use of indicia, and as such, the actual claimed structure being shown, is not given patentable weight. As to claim 39, the specific relative location of these elements is also an obvious matter of choice in the location of known element to one of ordinary skill in the art.

Claim 48 is rejected under 35 U.S.C. 103(a) as being unpatentable over Conger, Sr. (4648840) in view of Sadohara (4608017), Maurer et al (2643456) and Fischer (5289919) as applied to claim 47 above, and further in view of Mabile (4676749). The above combination does not show a reduced cross section. Mabile shows using a reduced cross section, Fig. 1, column 3, lines 58-65. It would be obvious to one of ordinary skill in the art to modify the above combination to include a reduced cross section as shown by Mabile in order to better fit the elements within the tip as shown.

Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Conger, Sr. (4648840) in view of Sadohara (4608017), Maurer et al (2643456) and Fischer

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(5289919) as applied to claim 47 above, and further in view of Tilden (2814877). The above combination does not show a bayonet connection. Tilden teaches that it is known to use the alternatives of treaded or bayonet connections when attaching nozzles, column 4, lines 60-64. It would be obvious to one of ordinary skill in the art to modify the above combination to include a bayonet connection as shown by Tilden in order to make use of art known alternatives to best attach a nozzle to an abrasive tool.

Claim 37 is rejected under 35 U.S.C. 103(a) as being unpatentable over Conger, Sr. (4648840) in view of Sadohara (4608017) as applied to claim 36 above, and further in view of Karst (4950160). Conger shows the structure as described above, and further shows locating the supply at an angle to the longitudinal axis of the hand piece while locating the coupling means on the axis, and as such, the above combination does not show reversing the location of these elements. Karst shows locating the coupling means as shown at the bottom of 12, at an angle to the longitudinal axis. It would be obvious to one of ordinary skill in the art to modify the above combination to include locating the coupling means at an angle as shown by Karst in order to choose the desired location of known elements so as to enable a better grip of the instrument.

Claim 41 is rejected under 35 U.S.C. 103(a) as being unpatentable over Conger, Sr. (4648840) in view of Sadohara (4608017) as applied to claim 40 above, and further in view of Saupe et al (4696645). The above combination does not show arranging the gas feed line at the rear of the therapeutic line. Saupe shows locating feed line 90, Fig.

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7, at the rear of feed line 87. It would be obvious to one of ordinary skill in the art to modify the above combination to include locating one feed line to the rear of another as shown by Saupe in order to make use of known locations of elements in coupling members to best couple the elements together.

Claims 34, 36, 40, 41, 43 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Black (2696049) in view of Maurer et al (2643456) and Fischer (5289919). Black shows the structure described above, however, does not show a plurality of needles having different shapes, sizes and opening sizes. Maurer teaches using a plurality of needles having different shapes and opening sizes, Figs. 12-21. It would be obvious to one of ordinary skill in the art to modify Black to include using a plurality of nozzles as shown by Maurer in order to better apply the abrasive in the desired manner. That different sizes can be used is an obvious matter of choice in the size of known elements to one of ordinary skill in the art in order to best reach desired areas in the mouth of the patient. The above combination does not show using colored markings. Fischer teaches different size tips having color markings, column 4, lines 12-25. It would be obvious to one of ordinary skill in the art to modify the above combination to include color markings as shown by Fischer in order to distinguish the different tips used. To associate the color markings with different therapeutic agents is merely a matter of mental interpretation and/or intended use of indicia, and as such, the actual claimed structure being shown, is not given patentable weight. As to claim 39, the specific relative location of these elements is also an obvious matter of choice in the

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location of known element to one of ordinary skill in the art. As to claim 40, to include more than one line would be obvious in view of Sadohara. The specific location of the lines is an obvious matter of choice in the location of known element to the skilled artisan.

Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Black (2696049) in view of Maurer et al (2643456) and Fischer (5289919) as applied to claim 47 above, and further in view of Tilden (2814877). The above combination does not show a bayonet connection. Tilden teaches that it is known to use the alternatives of treaded or bayonet connections when attaching nozzles, column 4, lines 60-64. It would be obvious to one of ordinary skill in the art to modify the above combination to include a bayonet connection as shown by Tilden in order to make use of art known alternatives to best attach a nozzle to an abrasive tool.

Claims 37-39 is rejected under 35 U.S.C. 103(a) as being unpatentable over Black (2696049) in view of Maurer et al (2643456) and Fischer (5289919) as applied to claim 36 above, and further in view of Karst (4950160). The above combination does not show locating the coupling means at an angle. Karst shows locating the coupling means as shown at the bottom of 12, at an angle to the longitudinal axis. It would be obvious to one of ordinary skill in the art to modify the above combination to include locating the coupling means at an angle as shown by Karst in order to choose the desired location of known elements so as to enable a better grip of the instrument. As

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to claim 38, the above combination does not show using a storage container at the rear of the hand instrument. Karst shows using a storage container 18. It would be obvious to one of ordinary skill in the art to modify the above combination to include a storage container as shown by Karst in order to better supply the desired agent. As to claim 39, the specific relative location of these elements is also an obvious matter of choice in the location of known element to one of ordinary skill in the art.

Claim 48 is rejected under 35 U.S.C. 103(a) as being unpatentable over Black (2696049) in view of Maurer et al (2643456) and Fischer (5289919) as applied to claim 47 above, and further in view of Mabile (4676749). The above combination does not show a reduced cross section. Mabile shows using a reduced cross section, Fig. 1, column 3, lines 58-65. It would be obvious to one of ordinary skill in the art to modify the above combination to include a reduced cross section as shown by Mabile in order to better fit the elements within the tip as shown.

Response to Arguments

Applicant's arguments filed March 20, 2007 have been fully considered but they are not persuasive. Applicant's remarks are held to be moot in view of the newly applied reference to Black and Sadohara applied above.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John J. Wilson whose telephone number is 571-272-4722. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cris Rodriguez, can be reached at 571-272-4964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

***/John J Wilson/
Primary Examiner
Art Unit 3732***

jw
June 28, 2007